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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,235	06/05/2001	Hiroimi Ohara	109697	4542
25944	7590	11/16/2004	EXAMINER PARK, CHAN S	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,235

Applicant(s)

OHARA, HIROMI

Examiner

CHAN S PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 3, is attached to the instant Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to page 9, lines 9-15 of the Specification, the Applicant seems to teach/suggest that the produced image data is stored outside of the image input device. Since the storing location refers to the memory location in the scanserver and the scanserver does not comprise the printing instruction information setting means and the image data producing means, Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: storing the image data produced by the image data producing means to a storage that is outside of the image input device.

Since the claim wording is not clear as to where the produced image data is stored inside the image input device, Examiner interprets that the produced image data is stored inside the image input device.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by Owa et al.

U.S. Patent No. 6,348,971 (hereinafter Owa).

3. With respect to claim 3, Owa discloses a printing system (fig. 2) comprising an image input device, multiple printers, and a printing management device receiving printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers, the image input device (host computer 1 in fig. 2) comprising:  
printing instruction information setting means (print condition input section 14) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 17-33 & col. 12, lines 35-44);

image data producing means (print data generation section 18) for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48); and

transmitting means for transmitting (data transfer system 17) the printing instruction information set by the printing instruction information setting means and information on a storing location of the image data produced by the image data producing means (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50) to the printing management device (server 3), and

the printing management device (col. 17, lines 35-58) comprising:

storage management means for storing and managing the printing instruction information and the information on the storing location of the image data transmitted from the transmission means in association with each other (the information must be stored in a memory for selecting the optimum printer in col. 17, lines 44-51 & col. 3, lines 41-50); and

transmission control means for transmitting the image data corresponding to the desired printer based on the printing instruction information stored and managed by the storage management means to the desired printer from the storing location of the image data indicated in the information on the storing location (col. 17, lines 50-51).

Again, referring to col. 17, lines 44-51, when the server is used and the output destination printer selection section 11, the basic information setting section 12, and the status monitor section 13 are installed in the server 3, the server selects the optimum printer based on the various conditions specified by the host. Moreover, based on the

selection, the host sends the image data, which is apparently stored in the host, to the optimum printer for printing. Note that when the server selects the optimum printer and informs the host computer 1 (col. 17, lines 50-51), the server must be able to distinguish the host computer 1 among other host computers (line 38 and fig. 1). Hence, it is apparent to one of ordinary skill in the art that the server must be initially notified with the information on host computer which is the storing location of the image data. Without that information, the server would not be able to notify the selected result to the appropriate host.

Therefore, Owa discloses the invention as specified in claim 3.

4. With respect to claim 4, Owa discloses the printing system according to claim 3, wherein

the printing instruction information setting means sets printing instruction information including specification of multiple desired printers (col. 12, lines 54-67),

the image data producing means produces multiple pieces of image data corresponding to the respective multiple desired printers included in printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48 and S48 in fig. 11),

the transmitting means transmits information on storing locations of the respective multiple pieces of image data together with the printing instruction information to the printing management device (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50), and

the storage management means stores and manages the information on the storing locations of the multiple pieces of image data corresponding to the respective multiple desired printers (the information must be stored in a memory for selecting the optimum printer in col. 17, lines 44-51 & col. 3, lines 41-50).

Also, arguments analogous to those presented for claim 3, are applicable.

5. With respect to claim 9, arguments analogous to those presented for claim 3, are applicable.

6. With respect to claim 10, arguments analogous to those presented for claim 4, are applicable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owa in view of Bellucco et al. U.S. Patent No. 5,930,465 (hereinafter Bellucco).

7. With respect to claim 1, Owa discloses a printing system (fig. 2) comprising an image input device, multiple printers, and a printing management device receiving

printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers,

the image input device (host computer 1 in fig. 2) comprising:

printing instruction information setting means (print condition input section 14) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 17-33 & col. 12, lines 35-44);

image data producing means (print data generation section 18) for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48); and

transmitting means (data transfer system 17) for transmitting the printing instruction information set by the printing instruction information setting means (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50) to the printing management device (server 3), and

the printing management device (col. 17, lines 35-58) comprising:

storage management means for storing and managing the printing instruction information transmitted from the transmitting means in association with each other (the information must be stored in a memory for selecting the optimum printer in col. 17, lines 44-51 & col. 3, lines 41-50); and

transmission control means for transmitting the selected optimum printer information to the host (col. 17, lines 50-51).



Owa, however, does not disclose expressly that the printing management device receives the image data and transmits the image data to the selected optimum/desired printer.

Bellucco, on the other hand, discloses a printing system (fig. 1) comprising an image input device, multiple printers, and a printing management device receiving printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers,

the image input device (clients 15 in fig. 1) comprising:

printing instruction information setting means (UI 16 in fig. 2) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 27-36);

image data producing means for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 7-12 and lines 27-36); and

transmitting means (connection between the clients 15 and the server 15) for transmitting the printing instruction information set by the printing instruction information setting means and *the image data produced by the image data producing means to the printing management device* (col. 4, lines 27-36 and fig. 1), and

*the printing management device (server 25) for storing the image data in a storage (file 43) and transmitting the image data to an appropriate printer.*

Owa and Bellucco are analogous art because they are from the same field of endeavor that is the network printer.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the image data transmitting server to a printer of Bellucco into the printing system of Owa.

The suggestion/motivation for doing so would have been to provide a server that transmits the image data to an optimum printer upon selecting the optimum printer for a particular print job (col. 4, lines 46-64 of Bellucco).

Therefore, it would have been obvious to combine Owa with Bellucco to obtain the invention as specified in claim 1.

8. With respect to claim 2, Owa further discloses the printing system wherein the printing instruction information setting means sets printing instruction information including specification of multiple desired printers (col. 12, lines 54-67), the image data producing means produces multiple pieces of image data corresponding to the respective multiple desired printers included in the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48 and S48 in fig. 11), and

the transmitting means transmits the printing instruction information to the printing management device (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50), and

Again, with the combination of Owa and Bellucco as presented for claim 1, the transmitting of the image data from the host/client to the server and the transmitting of the image data from the server to the optimum printers are disclosed and taught.

9. With respect to claim 5, Owa further discloses the printing system wherein the multiple printers have functions different from each other (fig. 3), and

the image data producing means produces multiple pieces of image data corresponding to the respective functions of the multiple printers (col. 4, lines 44-48).

10. With respect to claim 6, Owa further discloses the printing system wherein the printing instruction information setting means comprises:

outputting method specifying means for specifying an outputting method in a printer (fig. 12a);

printer list display means for displaying a list of selectable printers based on the outputting method specified by the outputting method specifying means (fig. 12b);

printer specifying means for specifying a desired printer in the list of displayed printers (fig. 12b); and

setting means for setting an output mode by the printer specified by the printer specifying means (figs. 12a & b).

11. With respect to claim 7, arguments analogous to those presented for claim 1, are applicable.

12. With respect to claim 8, arguments analogous to those presented for claim 2, are applicable.

13. With respect to claim 11, arguments analogous to those presented for claim 5, are applicable.

14. With respect to claim 12, arguments analogous to those presented for claim 6, are applicable.

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**Conclusion**


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
Examiner  
Art Unit 2622

csp  
November 11, 2004

  
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